

## REMARKS

In the Claims previously submitted claims 58-79, 86, and 96-102 were cancelled and claims 80, 83, 88, 90, 92 and 96 were amended and claims 103-137 were added. The amendments to the claims were to further clarify existing language or to change claim dependency as further noted in later remarks. Support for the added claims is found in the specification at the location indicated in the following table:

CLAIM	SUPPORT	CLAIM	SUPPORT
103	Same location as for claims 80, 71-72	121	Same location as for claim 77
104	Same location as for claim 59	122	Same location as for claim 78
105	Same location as for claim 61	123	Same location as for claim 71
106	Same location as for claim 62	124	Same location as for claim 88
107	Same location as for claim 63	125	Same location as for claim 74
108	Same location as for claim 64	126	Page 8 lines 4-8
109	Same location as for claim 65	127	Same location as for claim 96
110	Same location as for claim 66	128	Same location as for claim 97
111	Same location as for claim 67	129	Same location as for claim 98
112	Same location as for claim 68	130	Same location as for claim 99
113	Same location as for claim 65 and page 6 lines 1-3 and page 18 line 17-20 in example 5	131	Same location as for claim 101
114	Same location as for claim 69	132	Same location as for claim 102
115	Same location as for claim 70	133	Same location as for claim 65
116	Same location as for claim 71	134	Same location as for claim 66
117	Same location as for claim 73	135	Same location as for claim 67
118	Same location as for claim 74	136	Same location as for claim 68
119	Same location as for claim 75	137	Same location as for claim 80, 86
120	Same location as for claim 76		

Applicants note that the office action mailed April 20, 2006 indicated Claim 91 as allowable and claim 86 as objected to but allowable if rewritten in independent form with all the limitations of the base claim. Claim 137 is added to claim the subject matter of previously submitted claim 86 as an independent claim.

(A) RESPONSE TO REJECTIONS UNDER 35 U.S.C. 112

Claims 58 -- 79 and 92 -- 102 were rejected under section 112 first paragraph as failing to comply with the written description requirement. It was noted that the language, "polymers of alkyl monomers of styrene" was not supported in the originally filed specification. Claim 92 has been amended to correct that language with the use of the mis-placed "of" term, and the deletion of the extra words "alkyl monomers". Also, the new claims that have support in the specification at the same location as the claims objected to for this language do not have this language. Also the language "substituted (silane or multi--silanol )" is not present in the new claims 103 and 127 that find support in the specification at the same location as previously submitted claims 58 and 96.

Also previously submitted claims 58 -- 90, 92 -- 95, and 98 were rejected under section 112, second paragraph as being indefinite. It was noted that improper Markush language was recited and claims 58, 70, 77, 80, 83, 92 and 98. It is respectfully submitted that the language in the newly submitted claims that find support in the specification same location as some of these claims and amended claims 80, 83, and 92 utilize alternative claiming rather than Markush language. Such alternative claiming is consistent with the MPEP. Also the language "polymers of alkyl monomers of styrene" was objected to as unclear and indefinite. It is respectfully submitted that this language in the newly added claims and the amended claims has been corrected to delete the term "of" so that the language is now "polymer of styrene". Also the extraneous terms "alkyl monomers" are not used in this language. Therefore it is respectfully submitted that the amended and newly added claims comply with 35 USC 112.

(B) RESPONSE TO REJECTION UNDER 35 U.S.C. 102/103(a)

Previously submitted claims 80-85 and 87-90 were rejected under 35 U.S.C. 102(b) and alternatively by 103(a) from U.S. Patent 5,304,621, *Staiger, et al* patent (hereinafter '621').

It is respectfully submitted that claims 80-85 and 87-90 by the amendment to claim 80 are directed to an adhesive with a particular type of filler not taught or suggested in the '621 patent. As noted in the previous amendment the '621 patent does not teach a combination of fillers where the fumed silica has a surface area of less than  $150 \text{ m}^2/\text{gm}$  and particular clear fillers with a surface area 75 to less than  $250 \text{ m}^2/\text{gm}$  as now claimed in claim 80 and its dependent claims. Claim 80 has been modified to clarify as originally intended that both of the fillers i) and ii) are present.

Therefore it is respectfully submitted that claim 80 as amended for the fillers and claims dependent therefrom are novel and unobvious over the '621 patent.

(C) RESPONSE TO REJECTION UNDER 35 U.S.C. 103(a)

Previously submitted claims 80-85 and 87-90 were rejected under 35 U.S.C. 103(a) from the product brochure "MS Polymer Silyl of Kaneka Corporation (hereinafter Kaneka reference) in view of U.S. Patent 4,308,372 (Smith Jr. et. al. (hereinafter '372); *Staiger, et al* '621 patent; and/or *Imai et al*, '123 patent further in view of Hirosei et. al. (U.S. 4,593,068).

As is mentioned above with the clarification to Claim 80 that both types of recited clear fillers are present it is respectfully submitted that the combination of references does not teach or suggest this. The only mention in the Hirosei patent of silica filler is at column 8 lines 63-66. Here only "silica" is mentioned. This is not a teaching or suggestion of the combination of different surface area clear fillers one of which is fumed silica as is claimed in clarified Claim 80 and claims dependent therefrom.

Therefore it is respectfully submitted that claims 80-85 and 87-90 from the are unobvious over the cited references.

(D) RESPONSE TO REJECTION UNDER 35 U.S.C. 103(a)

Previously submitted claims 58-72, 74-85 and 87-90, 96, 97, and 99-102 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent 5,298,572 Katz (hereinafter "Katz '572) in view of *Staiger, et al* '621 patent or U.S. Patent 6,013,749 Baba hereinafter "Baba '749) and further in view of Hirosei et. al. (U.S. 4,593,068).

Claims 58 -- 79 and 96 -- 102 have been canceled. It is respectfully submitted that claims 87 -- 90 all are unobvious and patentable over the combined references for the same reason that the Hirose et al. patent does not teach or suggest the types of filler as claimed in the independent claim 80. In addition for Claims 91-95 the Hirose et.al. patent only mentions silica and not any specific surface area limitation of fumed silica as in Claim 91 or in addition to clear filler as in Claims 92-95.

In regards to the new claims, the combination of references does not teach the particular components including: a) the catalyst in the range of amounts, b) along with the dehydrated agent in a particular range of amounts, c) with the type of fumed silica in the recited range of amounts, and d) with the particular range of surface area for the types of carbon backboned polymers with reactive silicon end groups of the silyl end groups from the particular recited silanes to achieve the moisture curable adhesive with the particular viscosity and glass transition temperature. Also the combined references fail to reach or suggest the amounts of filler of about 5 weight percent or higher to achieve a clear curable adhesive with a particular viscosity as claimed in claim 113 and 127 and claims dependent therefrom.

It was mentioned in the Official Action that in regards to the surface area of less than 50 m<sup>2</sup> /gram, that this would be an obvious modification from more than 50 m<sup>2</sup> /gram since it is almost the same. The Official Action referred to the Staiger et al reference as noting a surface area of more than 50 m<sup>2</sup> /gram. Of course, this is taught for an compositional environment of a noncarbon backboned polymer in the Staiger reference which is the organo(poly)siloxane polymer. If the examiner is relying on personal knowledge or knowledge of someone in the United States Patent

and Trademark Office for the teaching that a surface area of less than 50 m<sup>2</sup> /gram is equivalent to a surface area of more than 50 m<sup>2</sup> /gram in the environment of carbon backboned polymers, the examiner is respectfully requested to make this information of reference by the filing of an affidavit under 37 C. F.R. 1.104(d)(2).

Therefore it is respectfully submitted that claims 80-85, 87-90, 91-95, and new claims 103-137 for the adhesive with the particular type of polymer(s) with the fillers and dehydrating agents are unobvious and patentable over the cited references.

#### (E) RESPONSE TO REJECTION UNDER 35 U.S.C. 103(a)

Previously submitted claims 58-85 and 87-90 were rejected under 35 U.S.C. 103(a) as unpatentable over Katz '572 in view of *Staiger, et al* '621 patent or Baba '749 and further in view of Hirosei et. al. (U.S. 4,593,068) and further in view of Furukawa et. al. U.S. 5,459,205 (hereinafter referred to as "'205) or Yamaguchi et. al., U.S. Patent 6,686,047 (hereinafter referred to as "'047).

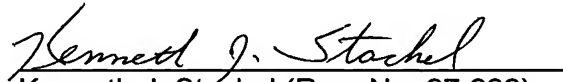
Claims 58 -- 79 and 96 -- 102 have been canceled. It is respectfully submitted that claims 87 -- 90 and 91-95 all are unobvious and patentable over the combined references for the same reason that the Hirose et al. patent does not teach or suggest the types of fillers as claimed in the independent claims 80, 91 and 92 and claims dependent therefrom.

In regards to the new claims 103-136, the combination of references does not teach or suggest the particular type of adhesive composition of Applicants' claims. There is no teaching or suggestion of the polymer having carbon in its backbone and with particular silyl end groups along with a particular filler with a particular surface area used in conjunction with the dehydrating agent in the range of amounts claimed in conjunction with the catalyst in an amount in the range of amounts claimed to result in the moisture curable adhesive. Neither the '205 reference nor the '047 reference teach or suggest such an adhesive composition comprised with such a polymer and filler and catalyst.

Reconsideration of claims 80– 85 and 87-95 and new claims 103-137 are respectfully requested. If there are any remaining issues regarding the allowance of the captioned patent application the examiner is requested to contact Applicants attorney in a telephone interview to resolve any such outstanding issues.

Respectfully submitted,

Date: October 20, 2006

A handwritten signature in cursive script, reading "Kenneth J. Stachel", is written over a horizontal line.

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